

REMARKS

Election/Restrictions

Examiner has required an election under 35 U.S.C. §121. During a telephone conversation on September 17, 2004, a provisional election was made without traverse to prosecute the invention of Species I., Claims 1-8, 10-20, 22, 23, 26 and 27. Applicant hereby affirms the election of Species I., Claims 1-8, 10-20, 22, 23, 26 and 27.

Drawings

The drawings stand objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because FIG. 3 includes reference character “216” not mentioned in the description.

The specification has been amended to include reference character “216.” Applicant respectfully submits that the drawings are currently in condition for allowance. Reconsideration and withdrawal of the objection is respectfully requested.

The drawings stand objected to under 37 C.F.R. §1.83(a) for failing to show every feature of the invention specified in Claims 2 and 13.

Claims 2 and 13 have been canceled. Applicant respectfully submits that the drawings are currently in condition for allowance. Reconsideration and withdrawal of the objection is respectfully requested.

Claim Rejections – 35 U.S.C. §112

Claims 2 and 13 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claims 2 and 13 have been canceled. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 2, 13, 15, and 22 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As mentioned above, Claims 2 and 13 have been canceled.

Claim 15 has been amended to provide antecedent basis for “said stretchable material.” Applicant respectfully submits that Claim 15 is currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 12 has been amended to provide antecedent basis for “said releasable adhesive” in Claim 22. Applicant respectfully submits that Claim 22 is currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §102

Claims 1, 3-8, 11, 12, 14, 16-20, 23, 26 and 27 stand rejected under 35 U.S.C. §102(b) as being anticipated by Swierczek (US 5,024,014).

Directing Examiner’s attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a *prima facie* case for anticipation. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)”. “The identical invention must be shown in as complete detail as is contained in the ...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989).

Amended Claim 1 recites a folding advertising system for presenting a visual image on a railing comprising “a railing having an outer surface, said outer surface of said railing having a circumference; a body having a first side and a second side opposite said first side, said first side having printed indicia forming a visual image, wherein said body further comprises a first edge, a second edge opposite said first edge, a distance between said first edge and said second edge, and a width defined by said distance between said first edge and said second edge, said width substantially equal to said circumference of said outer surface of said railing so that said first edge and said second edge may abut, but not overlap....”

Swierczek fails to disclose a folding advertising system for presenting a visual image on a railing comprising a railing, a body having a width between two edges that is substantially equal to the circumference of the railing so that the edges may abut, but not overlap, and a releasable adhesive disposed on the body and adhered to the railing.

Swierczek is only directed towards “a label that can be separated from the bottle or container for use as a coaster.” (Col. 1, lines 9-11). Clearly, neither a bottle nor a container constitutes a railing. There is no mention at all of a railing, a body having a width substantially similar to the circumference of a railing, or a releasable adhesive disposed on the body and adhered to a railing.

Applicant respectfully submits that Swierczek fails to teach each and every element of Claim 1 of the present invention. Additionally, there is no suggestion in Swierczek that would motivate one skilled in the art to modify the label coaster of Swierczek in order to arrive at the folding advertising system as recited in Claim 1. Therefore, Applicant respectfully submits that Claim 1 is currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Since Claims 3-8 and 11 are dependent from Claim 1, they are also patentable as they contain the same limitations as Claim 1. Therefore, Applicant respectfully submits that Claims 3-8 and 11 are currently in condition for allowance.

The same arguments made above with respect to the patentability of Claim 1 are applicable to the patentability of Claim 12 as well since Swierczek fails to disclose a grab bar or a body releasably adhered to a grab bar wherein the body has a width between two edges that is substantially equal to the circumference of the outer surface of the grab bar so that the first edge and the second edge may abut, but not overlap. Swierczek is only directed towards a label coaster for a beverage container. Clearly, neither a bottle nor a container constitutes a grab bar. Additionally, there is no suggestion in Swierczek that would motivate one skilled in the art to modify the label coaster of Swierczek in order to arrive at the folding advertising system as recited in Claim 12. Reconsideration and withdrawal of this rejection is respectfully requested.

Since Claims 14, 16-20 and 23 are dependent from Claim 12, they are also patentable as they contain the same limitations as Claim 12. Therefore, Applicant respectfully submits that Claims 14, 16-20 and 23 are currently in condition for allowance. Reconsideration and withdrawal of these rejections is respectfully requested.

The same arguments made above with respect to the patentability of Claim 1 are applicable to the patentability of Claim 26 as well since Swierczek fails to disclose a pole or a body releasably adhered to a pole wherein the body has a width between two edges that is substantially equal to the circumference of the pole. Swierczek is only directed towards a label coaster for a beverage container. Clearly, neither a bottle nor a container constitutes a pole. Additionally, there is no suggestion in Swierczek that would motivate one skilled in the art to modify the label coaster of Swierczek in order to arrive at the folding advertising system as recited in Claim 26. Reconsideration and withdrawal of this rejection is respectfully requested.

Since Claim 27 is dependent from Claim 26, it is also patentable as it contains the same limitations as Claim 26. Therefore, Applicant respectfully submits that Claim

27 is currently in condition for allowance. Reconsideration and withdrawal of these rejections is respectfully requested.

Claim Rejections – 35 U.S.C. §103

Claims 1, 10, 12, 15 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shacklett (US 5,292,566) in view of Gozdecki et al. (US 5,639,529).

For a §103 obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. MPEP 2143.

Regarding Claim 1, neither Shacklett nor Gozdecki disclose a folding advertising system for presenting a visual image on a railing comprising a railing, a body having a width between two edges that is substantially equal to the circumference of the railing, and a releasable adhesive disposed on the body and adhered to the railing.

Shacklett only discloses a label that is “affixed to a battery body.” (Col. 3, lines 33-36). A battery is clearly not a railing. Applicant cannot find in Shacklett any mention of a railing, a body having a width substantially similar to the circumference of a railing, or a releasable adhesive disposed on the body and adhered to a railing.

Gozdecki only discloses “an easily removable label that is securely attached to a container” (Col. 1, lines 6-9). A container is clearly not a railing. Applicant cannot find in Gozdecki any mention of a railing, a body having a width substantially similar to

the circumference of a railing, or a releasable adhesive disposed on the body and adhered to a railing.

Since neither Shacklett nor Gozdecki disclose railing, a body having a width substantially similar to the circumference of a railing, or a releasable adhesive disposed on the body and adhered to a railing, there combination cannot disclose these limitations.

Furthermore, there is no suggestion or incentive found in either Shacklett or Gozdecki that would motivate one skilled in the art to modify either one in order to arrive at the subject matter of the present invention as recited in Claim 1. One skilled in the art would not look to labels for batteries and containers in order to solve the particular problems associated with an advertising system for a railing.

Applicant respectfully submits that Claim 1 is currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

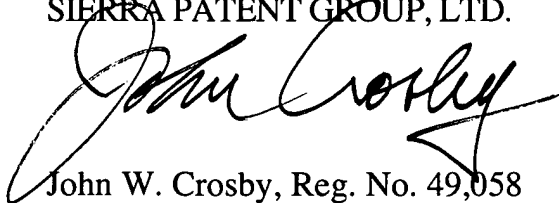
Since Claims 10 and 15 are dependent from Claim 1, they are also patentable as they contain the same limitations as Claim 1. Therefore, Applicant respectfully submits that Claims 10 and 15 are currently in condition for allowance.

The same arguments made above with respect to the patentability of Claim 1 are applicable to the patentability of Claim 12 as well since Swierczek fails to disclose a grab bar or a body releasably adhered to a grab bar wherein the body has a width between two edges that is substantially equal to the circumference of the grab bar. Additionally, there is no suggestion in Swierczek that would motivate one skilled in the art to modify the label coaster of Swierczek in order to arrive at the folding advertising system as recited in Claim 12. Reconsideration and withdrawal of this rejection is respectfully requested.

Since Claim 22 is dependent from Claim 12, it is also patentable as it contains the same limitations as Claim 12. Therefore, Applicant respectfully submits that Claim 22 is currently in condition for allowance.

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

A handwritten signature in black ink, appearing to read "John W. Crosby", is written over the typed name and registration number.

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